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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,366	03/27/2000	Christopher J. Edge	53492USA02 (EKC 90218B)	3630
1333 7590 07/02/2007 EASTMAN KODAK COMPANY PATENT LEGAL STAFF 343 STATE STREET ROCHESTER, NY 14650-2201			EXAMINER BRIER, JEFFERY A	
			ART UNIT 2628	PAPER NUMBER
			MAIL DATE 07/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/536,366

Applicant(s)

EDGE ET AL.

Examiner

Jeffery A. Brier

Art Unit

2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-37, 47-53, 60, 61, 64 and 67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-37, 47-53, 60, 61, 64 and 67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/2/2007 has been entered.

Response to Amendment

2. The amendment filed on 4/17/2007 has been entered.

Response to Arguments

3. The 4/17/2007 amendments to the claims overcomes the 35 USC 101 and 112 first and second paragraph rejections with the exception of the user preference issue which is further addressed below. Additionally lack of antecedent basis issues have been discovered in claims 47-49 and 51-53 as well as a obvious type double patenting issues between this application and US patent no. 6,362,808 now reissue RE39,161. Both this application and US patent no. 6,362,808 are a continuation of parent patent application no. 08/882,561. In addition conflicting claims between this application and applicants copending application 11/611,190 is present and discussed below.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 33-37, 47-53, 60, 61, 64, and 67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 47:

At line 9 “a source device profile” is also claimed at line 4, thus, it is not clear if this a new source device profile or the same one present at line 4.

At line 12 “a destination device profile” is also claimed at line 4, thus, it is not clear if this a new destination device profile or the same one present at line 4.

At line 22 “the source and destination device profile interpreters” lack antecedent basis because at lines 9 and 12 “means for interpreting” are claimed.

At line 26 “the means for interpreting” lacks antecedent basis because at lines 9 and 12 are separate means for interpreting the source and destination device profiles while line 26 is claiming a single means is performing the interpreting.

Claims 48 and 49:

At line 2 of both claims “said source and destination device profile interpreters” lack antecedent basis because claim 47 claims at lines 9 and 12 “means” rather than interpreters.

Claim 51:

At line 25 "the source and destination device profile interpreters" lack antecedent basis because lines 8 and 11 claim steps rather than interpreters.

Claims 52 and 53:

At line 2 of both claims "said source and destination device profile interpreters" lack antecedent basis because claim 51 claims at lines 8 and 11 "steps" rather than interpreters.

Independent claims 33, 34, 35, 47, and 51 as well as their dependent claims:

The specification only describes the claimed user preferences in a very broad manner. See page 15 lines 19-22 which does not describe the types of user preferences and states:

The color management system 200 receives user preferences from an input 218 to determine how to configure the color transformer 214.

See page 18 lines 11-14 which states:

The device profile processor 308 can be configured for a variety of applications. For example, a user can select between absolute and relative colormetrics and can configure viewing conditions, such as observer or illuminant functions.

See page 35 lines 16-19 which states:

The user can specify the desired source, destination, and intermediate profiles and the user preferences used to generate the device profile link.

Clearly the specification does not describe the user preferences include color conversion preferences.

Claim 33:

At lines 15-20 this claim claims "a color transformer that generates a color map defining a relationship between the source and destination device color space based on ... user preferences, said user preferences being specified by a user... wherein the user preferences include color conversion preferences " but the type and scope of user preferences is unclear since the specification does not describe the user preferences as color conversion preferences. Note the June 18, 2007 CAFC decision titled 2006-1350 BIOMEDINO, LLC, v. WATERS TECHNOLOGIES CORPORATION as well as LizardTech Inc. v. Earth Resource Mapping Inc., 76 USPQ2d 1724 (Fed. Cir. 2005) and Lizardtech Inc. v. Earth Resource Mapping Inc., 77 USPQ2d 1391 (Fed. Cir. 2006).

Claim 34:

At lines 15-19 this claim claims "relationship between ... based on the converted coordinate and user preferences specified by a user independently of the source and destination device profiles" but the independence is unclear. See the amendment to claims 33 and 35 which more clearly claim the independence.

The claim limitations at lines 15-19 are similar to lines 15-20 of claim 33 and have the same issue of: the type and scope of user preferences is unclear since the specification does not describe the user preferences as color conversion preferences. Note the June 18, 2007 CAFC decision titled 2006-1350 BIOMEDINO, LLC, v. WATERS TECHNOLOGIES CORPORATION as well as LizardTech Inc. v. Earth Resource Mapping Inc., 76 USPQ2d 1724 (Fed. Cir. 2005) and Lizardtech Inc. v. Earth Resource Mapping Inc., 77 USPQ2d 1391 (Fed. Cir. 2006).

Claim 35:

The claim limitations at lines 15-21 are similar to lines 15-20 of claim 33 and have the same issue of: the type and scope of user preferences is unclear since the specification does not describe the user preferences as color conversion preferences. Note the June 18, 2007 CAFC decision titled 2006-1350 BIOMEDINO, LLC, v. WATERS TECHNOLOGIES CORPORATION as well as LizardTech Inc. v. Earth Resource Mapping Inc., 76 USPQ2d 1724 (Fed. Cir. 2005) and Lizardtech Inc. v. Earth Resource Mapping Inc., 77 USPQ2d 1391 (Fed. Cir. 2006).

Claim 47:

At lines 15-18, similar to claim 34, the independence is unclear. See the amendment to claims 33 and 35 which more clearly claim the independence.

The claim limitations at lines 15-19 are similar to lines 15-20 of claim 33 and have the same issue of: the type and scope of user preferences is unclear since the specification does not describe the user preferences as color conversion preferences. Note the June 18, 2007 CAFC decision titled 2006-1350 BIOMEDINO, LLC, v. WATERS TECHNOLOGIES CORPORATION as well as LizardTech Inc. v. Earth Resource Mapping Inc., 76 USPQ2d 1724 (Fed. Cir. 2005) and Lizardtech Inc. v. Earth Resource Mapping Inc., 77 USPQ2d 1391 (Fed. Cir. 2006).

Claim 51:

At lines 15-17, similar to claim 34, the independence is unclear. See the amendment to claims 33 and 35 which more clearly claim the independence.

The claim limitations at lines 14-18 are similar to lines 15-20 of claim 33 and have the same issue of: the type and scope of user preferences is unclear since the

does not describe the user preferences as color conversion preferences. Note the June 18, 2007 CAFC decision titled 2006-1350 BIOMEDINO, LLC, v. WATERS TECHNOLOGIES CORPORATION as well as LizardTech Inc. v. Earth Resource Mapping Inc., 76 USPQ2d 1724 (Fed. Cir. 2005) and Lizardtech Inc. v. Earth Resource Mapping Inc., 77 USPQ2d 1391 (Fed. Cir. 2006).

Dependent claims 36, 37, 48-50, 52, 53, 60, 61, 64, and 67 do not correct the independence issue and the user preferences issue of their respective parent claims discussed above.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 33, 34, 35, 47, and 51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/611,190. Although the conflicting claims are not identical,

they are not patentably distinct from each other because the sole claim of the '190 application covers in a very broad manner the above identified claims of this application. A side by side comparison of method claim 1 of the '190 application and method claim 51 of this application.

11/611,190	This application
<p>1. (Original) For use in transforming colors between color imaging systems, a color mapping method comprising:</p> <p>using forward transformation profiles that characterize the color imaging systems to generate respective sets of device-independent color values for the color imaging systems;</p>	<p>51 (currently amended). A method implemented, at least in part, by one or more computers, the method comprising:</p> <p>producing an image from image data using a source device profile;</p> <p>and</p> <p>reproducing said image from the image data using a destination device profile;</p> <p>wherein said reproducing further comprises:</p> <p>interpreting the source device profile to convert coordinates in a source device color space to a device-independent color space;</p> <p>interpreting the destination device profile to convert coordinates in a destination device color space to the device-independent color space; and</p> <p>generating a color map defining a relationship between the source and destination device color spaces based on the converted coordinates and user preferences specified by a user independently of the source and destination device profiles, wherein the user preferences include color conversion preferences; and</p> <p>using the color map to map colors between an image produced by a source device having said source device profile and a reproduction of said image produced by a destination device having said destination device profile;</p>

calculating color conversions by recursively reducing differences between the sets of device-independent color values; and constructing a color map describing a relationship between the color imaging systems using the color conversions.	by a destination device having said destination device profile; wherein generating a color map includes generating the color map in part by reducing color error between the converted coordinates from the source and destination device profile interpreters, said reducing at least adjusting coordinates in the destination device color space, the color map being based in part on said adjusted coordinates in the destination device color space; and wherein interpreting the source and destination device profiles includes using forward transformation profiles to produce the converted coordinates.
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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

It is clear from the above comparison the pending claims only differs from '190 claim 1 by claiming the features of claim 1 in more detail but since they have the same parent application and disclosure then the broader claim limitation of claim 1 covers the same invention claimed in this application in an obvious way. Thus, the minor variations between the pending claims and the patented claims is obvious type double patenting.

In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). On page 623 of *Vogel* the CCPA wrote:

[4] If it is determined that the same invention is being claimed twice, 35 U.S.C. 101 forbids the grant of the second patent, regardless of the presence or absence of a terminal disclaimer. If the same invention is not being claimed twice, a second question must be asked.

The second analysis question is: Does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent? In considering the question, the patent disclosure may not be used as prior art. *In re Boylan*, supra; *In re Aldrich*, 55 CCPA 1431, 398 F.2d 855, 158 USPQ 311 (1968). This does not mean that the

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disclosure may not be used at all. As pointed out above, in certain instances it may be used as a dictionary to learn the meaning of terms in a claim. It may also be used as required to answer the second analysis question above. We recognize that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim. A

[5] claim is a group of words defining only the boundary of the patent monopoly. It may not describe any physical thing and indeed may encompass physical things not yet dreamed of. How can it be obvious or not obvious to modify a legal boundary? The disclosure, however, sets forth at least one tangible embodiment within the claim, and it is less difficult and more meaningful to judge whether that thing has been modified in an obvious manner. It must be noted that this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined.

If the answer to the second question is no, there is no double patenting involved and no terminal disclaimer need be filed. If the answer is yes, a terminal disclaimer is required to prevent undue timewise extension of monopoly.

On page 623 last line to page 624 of Vogel the CCPA wrote:

Appealed claim 10, supra, will now be considered. It recites a process to be performed with "meat." "Meat" reads literally on pork. The only limitation appearing in claim 10 which is not disclosed in the available portion of the patent disclosure is the permeability range of the packaging material; but this is merely an obvious variation as shown by Ellies. The answer to the second analysis question, therefore, is yes, and the claim is not allowable in the absence of a terminal disclaimer. The correctness of this conclusion is demonstrated by observing that claim 10, by reciting "meat," includes pork. Its allowance for a full term would therefore extend the time of monopoly as to the pork process. It is further noted that viewing the inventions in reverse order, i.e. as though the broader claims issued first, does not reveal that the narrower (pork) process is in any way unobvious over the broader (meat) invention disclosed and claimed in the instant application. Emphasis added.

Thus, the slightly more narrower claims of this application are obvious over the slightly broader claims in the '190 application.

8. Claims 33-37, 47-53, 60, 61, 64, and 67 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over any one of independent claims 1, 2, or 4 of U.S. Patent No. 6,362,808 as modified by RE39,161. Although the conflicting claims are not identical, they are not patentably distinct from each other because independent claims 33, 35, 47, and 51, as well as their dependent claims, of this application are broader than claims 1, 2, or 4 of the reissued patent in that they do not explicitly claim the spectral data is stored in the profiles and because claim 34 of this application while claiming the raw spectral data is stored in the source device profile is still broader than claims 1, 2, or 4 of the reissued patent in that they do not explicitly claim reducing error claimed in the "determining color conversion by iteratively reducing difference between sets of device-independent color values" step. A side by side comparison of claim 1 of the reissued patent and claims 33, 34, and 35 of this application follows.

Claim 1 of the reissued patent	Claim 33 which is also representative of claims 47 and 51
1. For use in transforming color between color imaging systems, a color mapping method comprising: providing forward transformation profiles that characterize the color imaging systems;	33 (currently amended). A system for color mapping, the system comprising: a source device capable of producing an image from image data using a source device profile; a destination device capable of reproducing said image from the image data using a destination device profile; and a computer system operatively connecting said source device and

using the forward transformation profiles to generate respective sets of device-independent color values for the color imaging systems;

determining color conversions by iteratively reducing differences between the sets of device-independent color values, including performing a first reduction in differences between the device-independent color values for all color channels, wherein the fast reduction is multidimensional, and performing a second reduction in differences between the device-independent color values for the black channel in addition to the first reduction; and

constructing a color map describing a relationship between the color imaging systems using the color conversions, wherein the forward transformation profiles store spectral data, the method further comprising using the spectral data for reconstructing the profiles automatically.

destination device, said computer system including:

a source device profile interpreter that interprets a the source device profile to convert coordinates in a source device color space to a device-independent color space;

a destination device profile interpreter that interprets a the destination device profile to convert coordinates in a destination device color space to the device-independent color space; and

a color transformer that generates a color map defining a relationship between the source and destination device color spaces based on the converted coordinates and user preferences, said user preferences being specified by a user to configure the color transformer, wherein the user preferences include color conversion preferences,

wherein the color transformer generates the color map in part by reducing color error between said converted coordinates from the source and destination device profile interpreters, the color transformer, in said reducing, at least adjusting coordinates in the destination device color space to generate adjusted coordinates, the color map being based in part on said adjusted coordinates in the destination device color space, and

wherein the source and destination device profile interpreters use forward transformation profiles to produce said converted coordinates.

Claim 1 of the reissued patent	Claim 34
<p data-bbox="181 426 760 531">1. For use in transforming color between color imaging systems, a color mapping method comprising:</p> <p data-bbox="181 569 760 674">providing forward transformation profiles that characterize the color imaging systems;</p> <p data-bbox="181 1157 797 1304">using the forward transformation profiles to generate respective sets of device-independent color values for the color imaging systems;</p> <p data-bbox="181 1377 781 1808">determining color conversions by iteratively reducing differences between the sets of device-independent color values, including performing a first reduction in differences between the device-independent color values for all color channels, wherein the fast reduction is multidimensional, and performing a second reduction in differences between the device-independent color values for the black channel in addition to the first reduction; and</p>	<p data-bbox="823 426 1430 489">34 (currently amended). A system for color mapping, the system comprising:</p> <p data-bbox="823 569 1430 674">a source device capable of producing an image from image data using a source device profile;</p> <p data-bbox="823 684 1430 789">a destination device capable of reproducing said image from the image data using a destination device profile; and</p> <p data-bbox="823 800 1414 936">a computer system operatively connecting said source device and destination device, said computer system including:</p> <p data-bbox="823 947 1414 1115">a source device profile interpreter that interprets the source device profile to convert coordinates in a source device color space to a device-independent color space;</p> <p data-bbox="823 1157 1430 1335">a destination device profile interpreter that interprets the destination device profile to convert coordinates in a destination device color space to the device-independent color space; and</p> <p data-bbox="823 1377 1430 1692">a color transformer that generates a color map defining a relationship between the source and destination device color spaces based on the converted coordinates and user preferences specified by a user independently of the source and destination device profiles, wherein the user preferences include color conversion preferences,</p>

constructing a color map describing a relationship between the color imaging systems using the color conversions, <u>wherein the forward transformation profiles store spectral data, the method further comprising using the spectral data for reconstructing the profiles automatically.</u>	wherein the source device profile characterizes a source device <u>and contains raw spectral data used to construct said source device profile,</u> and the destination device profile characterizes a destination device <u>and contains raw spectral data used to construct said destination device profile.</u>
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Claim 1 of the reissued patent	Claim 35
<p>1. For use in transforming color between color imaging systems, a color mapping method comprising:</p> <p>providing forward transformation profiles that characterize the color imaging systems;</p> <p>using the forward transformation profiles to generate respective sets of device-independent color values for the color imaging systems;</p> <p>determining color conversions by iteratively reducing differences between the sets of device-independent color values, including performing a first reduction in differences between the</p>	<p>35 (currently amended). A system for color mapping, the system comprising:</p> <p>a source device capable of producing an image from image data using a source device profile;</p> <p>a destination device capable of reproducing said image from the image data using a destination device profile; and</p> <p>a computer system operatively connecting said source device and destination device, said computer system including:</p> <p>a source device profile interpreter that interprets a the source device profile to convert coordinates in a source device color space to a device-independent color space;</p> <p>a destination device profile interpreter that interprets the destination device profile to convert coordinates in a destination device color space to the device-independent color space; and</p> <p>a color transformer that generates a color map defining a relationship between the source and destination device color spaces based on the converted coordinates and user preferences, said</p>

<p>is multidimensional, and performing a second reduction in differences between the device-independent color values for the black channel in addition to the first reduction; and</p> <p>constructing a color map describing a relationship between the color imaging systems using the color conversions, <u>wherein the forward transformation profiles store spectral data, the method further comprising using the spectral data for reconstructing the profiles automatically.</u></p>	<p>destination device profiles; wherein the user preferences include color conversion preferences;</p> <p>wherein the source device profile defines a forward transformation from the source device color space to the device-independent color space; and wherein the destination device profile defines a forward transformation from the destination device color space to the device-independent color space.</p>
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From the above comparisons it is clear that the pending claims are broader versions of the patented claims because claims 33, 35, 47, and 51 as seen the above side by side comparison are broader than reissued claims 1, 2, or 4 in that they do not explicitly claim the spectral data is stored in the profiles and because claim 34 as seen the above side by side comparison are broader than reissued claims 1, 2, or 4 in that claim 34 does not explicitly claim reducing error claimed in the "determining color conversion by iteratively reducing difference between sets of device-independent color values". Broader versions of patented claims are an obvious way for applicant to claim the same thing patented. *In re Vogel*, 422 F.2d 438, 164 USPQ 619, 623 (CCPA 1970). Vogel stated on page 623 "*The answer to the second analysis question, therefore, is yes, and the claim is not allowable in the absence of a terminal disclaimer. The correctness of this conclusion is demonstrated by observing that claim 10, by reciting "meat," includes pork. It is further noted that viewing the inventions in reverse order, i.e. as though the broader claims issued first, does not reveal that the narrower (pork)*

as though the broader claims issued first, does not reveal that the narrower (pork) process is in any way unobvious over the broader (meat) invention disclosed and claimed in the instant application.” Thus, this application's broader claims are not unobvious over the above identified patented claims.

Another relevant CAFC decision is *In re Braat* (CA FC 1991) 19 USPQ2d 1289. Braat stated on page 1292 *“The following are excerpts from the Board's opinion: We agree with and sustain the rejection of claims 8, 9, 10, 13, 15, 16 and 17 on the basis of double patenting with respect to claims 5/1 and 6/1 of the Dil patent. The claims here being broader than claims 5/1 and 6/1 in the Dil Patent, the double patenting rejection is of the type created by the courts to prevent unjustified timewise extension of the right to exclude granted by a patent no matter how the exclusion [sic, extension] is brought about. See In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982).”* Braat also stated on page 1293 first full paragraph *“The only difference between the claims of Braat and claims 5/1 and 6/1 of Dil is the omission of the requirement in the claims of Dil of information areas having side walls which are angled at a particular angle, and we do not think that omission of such a limitation in the present case would constitute an unobvious modification.”*

9. A proper prior art analysis of the claims cannot be made because the metes and bounds of the claims are not definite and because the specification does not support the claims. Thus, a prior art rejection or an indication of allowability cannot be made with

the currently pending claims. In re Steele, 305 F.2d 859,134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:30 to 4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery A. Brier/
Primary Examiner, Division 2628